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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,737	10/15/2003	Richard A. Rubin	97,022-D1-CO	6145
20/306 7590 08/06/2009 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER SKIBINSKY, ANNA				
ART UNIT		PAPER NUMBER		
1631				
MAIL DATE		DELIVERY MODE		
08/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: RICHARD RUBIN, KENNETH GIULIANO, ALBERT GOUGH,
TERRY DUNLAY and BRUCE CONWAY

Application No. 10/685,737
Technology Center 1600

Mailed: August 5, 2009

Before TOI JOHNSON *Review Paralegal*

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on July 27, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, CLAIMS APPENDIX

A review of the Appeal Brief filed December 4, 2008 reveals that claims 40, 44-48 in the Claims appendix of the Appeal Brief are not consistent as amended in the last entered amendment filed on February 18, 2008. The copy of the claims should be in proper format and should not include any markings such as brackets or underlining except for claims in a reissue application in accordance with 37 CFR 41.37(c)(1)(viii). Furthermore, the Claims Appendix cannot assume entry of After Final Submissions for which an Advisory Action (or other Office communication) has not advised of entry. *See Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

Appropriate correction of all claims provided in the Claims Appendix in proper format is required.

EXAMINER'S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner's Answer mailed March 19, 2009 under the heading "Grounds of rejection" is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner's Answer must be consistent with the last Office action of record, including any Advisory

action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading “New Grounds of Rejection” in the Examiner’s Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 and 1207.03 (8th ed. Rev. 6, Sept 2007) for details.

A review of the Examiner’s Answer finds a new Ground(s) of Rejection that has not been provided the required heading “New Grounds of Rejection” and/or which does not include the approval of the TC Director or his/her designee.

Specifically, the Examiner’s Answer sets forth a rejection of claims 40-48 as being rejected under 35 U.S.C. 101. However, the Final Rejection mailed June 10, 2008 finds that a rejection under 101 was not discussed.

Authorization of the new grounds of rejection is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed on December 4, 2008 defective;

- 2) notify Appellant to file a “paper” which corrects the Claims Appendix, as an entire Appeal Brief is not necessary;
- 3) acknowledge and consider the “paper” filed by Appellant;
- 4) vacate the Examiner’s Answer mailed March 19, 2009;
- 5) generate a new Examiner’s Answer that include the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and
- 6) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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